Attorney Docket No.: RSW920030087US1 (7161-102U) **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 46320
Allen GILBERT, et al.	:	Confirmation Number: 1393
Application No.: 10/635,586	:	Group Art Unit: 2142
Filed: August 6, 2003	:	Examiner: C. Biagini
Appeal No. 2009-006032	:	

For: ONLINE AUTONOMIC OPERATIONS GUIDE

PETITION UNDER 37 C.F.R. § 41.3

Chief Administrative Patent Judge
Board of Patent Appeals and Interferences
US Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Petition seeks review of a procedural error in the Board's Decision on Request for Rehearing dated December 8, 2010, in which the Board denied Appellants' request that certain rejections be designated a new grounds of rejection pursuant to 37 C.F.R. § 41.50(b).

ISSUE PRESENTED

The issue is whether the Board erred in failing to designate a ground of rejection as a "new ground" under 37 C.F.R. § 41.50(b) when

(i) the Examiner expressly stated in the appealed Final Office Action that the Lortz reference does not teach particular limitations (instead, the Examiner relied on the Hopmann reference),

(ii) the Board, in the Decision on Appeal, relied upon new findings of fact as to the teachings of the Lortz reference, and

(iii) these findings of fact were not presented by the Examiner during appeal.

JURISDICTION

On June 9, 2010, the Board entered a Decision on Appeal affirming the Examiner's rejection of claim 1 under 35 U.S.C. § 103. On August 9, 2010, Appellants filed a Request for Rehearing under 37 U.S.C. § 41.52. In the Request for Rehearing, Appellants asserted that the Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Appeal Brief of February 22, 2008, and in the Reply Brief of June 17, 2008. Appellants also requested that the Board enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

On December 8, 2010, the Board entered a Decision on Request for Rehearing in which the Board disagreed that the Board either misapprehended and/or overlooked certain arguments presented by Appellants in the Appeal Brief and in the Reply Brief. The Board also denied

Appellants' request that a new ground of rejection be designated pursuant to 37 C.F.R. § 41.50(b).

The issue of whether or not a decision by the Board constitutes a new grounds of rejection involves the question as to whether or not the Board followed the regulations of the Patent Office, and a review of this issue is a proper exercise of supervisory authority. See In re Oku, 25 USPQ2d 1155 (Comm'r Pat. 1992) ("[t]he designation of a new ground of rejection ... involves the important question of whether the Board followed PTO regulations established by the Commissioner [and] the Commissioner may exercise his supervisory authority on petition"). This Petition is timely filed within 14 days of the Decision on Request for Hearing pursuant to 37 C.F.R. § 41.3(e).

STATEMENT OF LAW

An example of a "new grounds of rejection" was identified by the Federal Circuit within In re Kumar, 418 F.3d 1361, 1365 (Fed. Cir. 2005). A Final Office Action was issued in which claims 1-3, 5-16, and 19-22 were rejected under 35 U.S.C. § 103 based upon Rostoker alone or in view of Ueda. The Board of Patent Appeals & Interferences (hereinafter the BPAI) subsequent affirmed the Examiner's rejection based upon findings of fact (i.e., calculations) that were not presented by the Examiner. With regard to these new findings of fact, the Federal Circuit determined:

> These calculations had not been made by the examiner, and according to the record were not presented during the argument of the appeal to the Board. The Board apparently made these calculations during its decision of the appeal. The

> Board included these calculations in an Appendix to its decision, holding that they support a *prima facie* case of obviousness and that Kumar's evidence had not rebutted the *prima facie* case.

In addressing rebuttal evidence that was presented (and refused consideration) in response to the BPAI's findings, the Federal Circuit further stated:

> The values identified by the Board's calculations were not contained in the prior art or any examination record, but appeared for the first time in the Board's opinion. Although the PTO argues that the calculations the Board included in its decision were not new evidence, but simply an additional explanation of the Board's decision, these values produced and relied on by the Board had not previously been identified by the examiner or the Board. Kumar was entitled to respond to these calculations, and the Board committed procedural error in refusing to consider the evidence proffered in response.

In quoting In re Kronig, 539 F.2d 1300, 1302 (CCPA 1976), the Federal Circuit within Kumar stated "the ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection." The Federal Circuit concluded that "the Board's calculations and its decision based thereon constituted a new ground of rejection." Thus, the introduction of new findings, even though these findings related to a previously-presented rejection, constituted a new grounds of rejection.

Referring In re DeBlauwe, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984), the Federal Circuit further stated "[w]here the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence").

In response to the BPAI denying a request that the BPAI designate a rejection as "new" and allow new evidence to be introduced, within In re Ansel, 852, F.2d 1294 (Fed. Cir. 1988) (designated as an Unpublished Disposition), the Federal Circuit stated:

> We cannot agree with the board that its reasoning does not represent a significant shift in the basic thrust of the rejection. Not only do the rejections at issue here represent different views of what the cited references teach, they also require the applicants to respond in quite different manners.

The Court of Customs and Patent Appeals (i.e., the predecessor to the Federal Circuit), stated the following within In re Echerd, 471 F.2d 632, 635, 176 USPQ 321, 323 (CCPA 1973):

> We find the new reliance by the board on Gouveia alone to be in effect a new ground of rejection. New portions of the reference are relied upon to support an entirely new theory … [u]nder such circumstances, appellants should have been accorded an opportunity to present rebuttal evidence.

STATEMENT OF FACTS

In the ninth enumerated paragraph on page 7 of the Second and Final Office Action dated August 21, 2007 (hereinafter the appealed Final Office Action) and with regard to independent claim 1, the Examiner asserted the following:

> Lortz does not show the policy evaluation component configured to retrieve resource state data and determine whether said retrieved resource data satisfies rules in said administration policy.

The above-reproduced assertion was repeated again by the Examiner on page 5 of the Examiner's Answer

In the last full paragraph on page 10 of the Decision on Appeal, the Board asserted the following:

> We concentrate on Lortz for *all of the limitations* of claim 1. We regard the Hopmann reference as cumulative prior art, in that it discloses accessing a resource on a computer system on the basis of whether a file is locked (*i.e.*, in use by a computer user) or unlocked (*i.e.*, not in use by a computer user) (FF#3). (emphasis added)

In the paragraph spanning pages 10 and 11 of the Decision in which the Board wrote:

> We find that Lortz discloses a policy structure with two portions: a device policy and a user policy (FF#2). We read Lortz's device policy as being similar to Appellants' claimed "state data." We note that Appellants chose not to specifically limit the meaning of "state data." (Spec. ¶ [0026]). Rather, Appellants merely provided examples of state data (*id.*). Reading the claim language broadly but reasonably, *see Zletz*, cited above, we find that Appellants' claimed "state

> data" reads on Lortz's "device policy." We find that Lortz must retrieve a first portion (Appellants' claimed "state data") of the policy structure and a second portion (Appellants' claimed "retrieved policy") to gain access to a resource (Appellants' claimed "resource"). Lortz's disclosure is no different from Appellants' claim limitations "retrieving state data for said resource and applying said retrieved policy to said retrieved state data" and "permitting said administrative task only if said retrieved state data satisfies said set of rules in said retrieved policy." Accordingly, we find no error in the Examiner's conclusion of obviousness. (emphasis added)

In responding to Appellants' request that a new ground of rejection be entered, the Board responded on page 5 of the Decision on Request for Rehearing as follows:

> However, under the facts of this case, we neither impermissibly converted the obviousness rejection into an anticipation rejection nor added a new ground of rejection. The basis for the Examiner's rejection remains 35 U.S.C. § 103(a) obviousness. The evidence considered by the Examiner to demonstrate obviousness included, principally, the Lortz and Hopmann patents. In affirming, the Board used the same basis but, without disagreeing with the Examiner's approach, limited its discussion to the evidence contained in Lortz. *See id.* at 1303.

ARGUMENT

1. The Board's Characterization of Lortz and the Examiner's Characterization of Lortz are Different

With regard to independent claim 1, the Examiner asserted the following:

> Lortz does not show the policy evaluation component configured to retrieve resource state data and determine whether said retrieved resource data satisfies rules in said administration policy. (emphasis added)

(ninth enumerated paragraph of the appealed Office Action and page 5 of the Examiner's Answer). Thus, the Examiner has explicitly asserted that the primary reference of Lortz does not teach "the policy evaluation component configured to retrieve resource state data and determine whether said retrieved resource data satisfies rules in said administration policy."

In contrast, the Board asserted the "we concentrate on Lortz for all of the limitations of claim 1" (emphasis added) (last full paragraph on page 10 of the Decision on Appeal). Specifically, the Board asserted that "Appellants' claimed 'state data' reads on Lortz's 'device policy'" (sentence spanning pages 10 and 11 of the Decision on Appeal) and "Lortz's disclosure is no different from Appellants' claim limitations" (line 5 on page 11 of the Decision on Appeal).

Within In re Ansel, the Federal Circuit stated that "[n]ot only do the rejections at issue here represent different views of what the cited references teach, they also require the applicants to respond in quite different manners." In the present situation, the Board and the Examiner have different views of what Lortz teaches – the Examiner believes that Lortz fails to teach certain

limitations, whereas the Board believes that Lortz can be relied upon to teach all of the limitations.

The appealed grounds of rejection presented by the Examiner requires not only an analysis of both Lortz, as to some (but not all) of the limitations, and Hopmann, as to others of the limitations, these appealed grounds of rejection requires an analysis of the Examiner's obviousness analysis regarding the combination of Lortz and Hopmann. On the contrary, since the Board relied upon Lortz for all of the limitations, Appellants have to focus on Lortz for all of the limitations, which requires Appellants to respond in a different way than how Appellants responded to the Examiner's rejection based upon the combination of Lortz and Hopmann. Additionally, Appellants also have to respond to an obviousness analysis[1] based upon a single reference, which also requires Appellants to respond in a different way than how Appellants responded to the two-reference combination of Lortz and Hopmann. Therefore, under the law discussed within In re Ansel, designation of a new grounds of rejection is necessary.

2. The Board Inaccurately Denies that the Characterizations are Different

The Board asserted that "the Board used the same basis, but without disagreeing with the Examiner's approach, limited its discussion to the evidence contained in Lortz" (emphasis added) (lines 14-16 on page 5 of Decision on Request for Rehearing). The term "Examiner's approach" does not have any legally-recognized meaning within 'new grounds' jurisprudence. As such, the Board has muddied the issues by not clearly explaining what was meant when the Board asserted that the Board did not disagree with "the Examiner's approach."

[1] Although the Board's assertion that Lortz is relied upon to teach all of the limitations of claim 1 implies a rejection under 35 U.S.C. § 102, the Board maintains that the rejection is based upon 35 U.S.C. § 103.

Notwithstanding the Board's assertion that they did not disagree with the Examiner's approach, the Board disagreed with the Examiner's explicit findings of fact. Specifically, in contrast to the Examiner's assertion that Lortz does not teach specific limitations found in claim 1, the Board disagreed by asserting "we concentrate on Lortz for all of the limitations of claim 1" (emphasis added).

3. Appellants have Not had a Fair Opportunity to React

As discussed within In re Kumar, "the ultimate criterion of whether a rejection is considered 'new' in a decision by the Board is whether Appellants have had fair opportunity to react to the thrust of the rejection." Although citing this case law in the Decision on Request for Rehearing while rejecting Appellants' request that a new grounds of rejection be designated, the Board did not explain how Appellants had a fair opportunity to react to this particular thrust of the rejection (i.e., the reliance by the Board upon "Lortz for all of the limitations").

Once the Examiner admitted that Lortz did not teach the limitations at issue, Appellants' analysis during appeal focused on the secondary reference of Hopmann and the Examiner's obviousness analysis regarding the combination of Lortz and Hopmann. Specifically, referring to page 7, line 19 through page 9, line 2 of the Appeal Brief, Appellants' arguments focused on Hopmann's failure to teach certain of the claimed limitations at issue and how the Lortz and Hopmann, even if combined, would not arrive at the claimed invention. These same points were also emphasized by Appellants on page 4, line 11 through page 6, line 7 of the Reply Brief. By relying upon "Lortz for all of the limitations of claim 1," the Board has rendered all of

Appellants' arguments as to these points moot. Therefore, not only did Appellants not have an opportunity to *react* to the thrust of the grounds of rejection newly presented by the Board, the Board's new thrust of the rejection rendered moot all of Appellants' prior arguments regarding the limitations at issue. Therefore, under the law discussed within In re Kumar, designation of a new grounds of rejection is necessary.

4. Board's Alleged Reliance upon the Same Statutory Grounds does Not Prevent New Grounds from being Designated

The Board also asserted "[t]he basis for the Examiner's rejection remains 35 U.S.C. § 103(a) obviousness." (page 5, lines 11-12 of the Decision on Request for Rehearing). However, the Board did not explain the relevance of this assertion in the context of "new grounds" jurisprudence.

As stated within In re Kumar, the fact that the Board maintained the same statutory grounds (e.g., 35 U.S.C. § 103) based upon the same combination of references was not dispositive as to whether or not new grounds of rejection should have been designated. The Federal Circuit determined that although the Board relied upon the same references and the same statutory rejection, the Board relied upon new findings within these references to support this statutory rejection, which is sufficient to require that a new grounds of rejection be designated. Therefore, the Board's observation in the Decision on Request for Rehearing that "[t]he basis for the Examiner's rejection remains 35 U.S.C. § 103(a) obviousness" has no relevance to the issue of whether or not the Board introduced a new ground of rejection.

5. Board's Analysis Presents New Issues and New Rationales

Immediately after the Board asserted that "[t]he basis for the Examiner's rejection remains 35 U.S.C. § 103(a) obviousness," the Board also asserted "[t]he evidence considered by the Examiner to demonstrate obviousness included, principally, the Lortz and Hopmann patents." Again, the Board presents an assertion that does not have an apparent relevance to the issues at hand. Appellants did not contest that the Examiner relied upon both Lortz and Hopmann in the appealed Final Office Action in rejecting claim 1. However, the Board did not rely upon Hopmann with regard to the limitations at issue since the Board relied upon "Lortz for all of the limitations of claim 1."

As discussed within In re DeBlauwe, "[w]here the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence." In this instance, the Board's position that Lortz can be relied upon for all of the limitations of independent claim 1 is a position that is new to the proceedings. Not only is this position new to the proceedings, this position directly contradicts the position taken by the Examiner in the appealed Final Office Action. Moreover, Appellants have not had any opportunity to respond, by the submission of contradicting evidence, to this new position taken by the Board. Therefore, under the law discussed within In re DeBlauwe, designation of a new grounds of rejection is necessary.

As discussed within In re Echerd, "[w]e find the new reliance by the board on Gouveia alone to be in effect a new ground of rejection" because "[n]ew portions of the reference are relied upon to support an entirely new theory and the statutory basis for rejection appears to have

been shifted to 35 U.S.C. § 102." In the Decision on Request for Rehearing, the Board asserts that "[t]he basis for the Examiner's rejection remains 35 U.S.C. § 103(a) obviousness." However, the Board fails to explain how this is consistent with the Examiner's rejection of claim 1 when the Board explicitly relies upon "Lortz for all of the limitations of claim 1" (emphasis added).

The Examiner's articulated reasoning for modifying Lortz to arrive at the limitations at issue is based upon the teachings of Hopmann (see sixth enumerated paragraph on page 6 of the appealed Final Office Action and second full paragraph on page 4 of the Examiner's Answer). However, since the Board has relied upon Lortz alone for all of the limitations, the articulated reasoning for the asserted obviousness rejection must necessarily differ from the articulated reasoning originally presented by the Examiner in the appealed Final Office Action. However, this new reasoning (i.e., theory) has not been articulated by the Board. Regardless, whether or not the Board has rejected claim 1 under 35 U.S.C. § 102 based upon Lortz or rejected claim 1 under 35 U.S.C. § 103 based upon Lortz, the Board's analysis necessarily presents a new theory, to which Appellants have not had the opportunity respond. Therefore, under the law discussed within In re Echerd, designation of a new grounds of rejection is necessary.

PRAYER FOR RELIEF

Appellants respectfully request that the Board's rejection of claim 1 be designated a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: December 21, 2010

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul
Registration No. 42,984
Steven M. Greenberg
Registration No. 44,725
Phone: (561) 922-3845
CUSTOMER NUMBER 46320